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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/596,902

08/29/2006

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112857-567

1992

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08/19/2010

EXAMINER

CHOWDHURY, NIGAR

ART UNIT

PAPER NUMBER

2621

NOTIFICATION DATE

DELIVERY MODE

08/19/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/596,902	<b>Applicant(s)</b> TSUJII ET AL.	
	<b>Examiner</b> NIGAR CHOWDHURY	<b>Art Unit</b> 2621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/28/06, 9/2/08, 3/6/09</u> .                                 | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

1. Claim(s) 8, 12 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 8 defines **a program** embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory

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in most cases since use of technology permits the function of the descriptive material to be realized” – Guidelines Annex IV). That is, the scope of the presently claimed a program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. Any amendment to the claim should be commensurate with its corresponding disclosure.

2. Claim(s) 9, 13 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 8 defines **a storage medium** embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., “When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized” – Guidelines Annex IV). That is, the scope of the presently claimed a storage medium can range from paper on which the program is written, to a program simply contemplated and memorized by a person. Any amendment to the claim should be commensurate with its corresponding disclosure.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-13 rejected under 35 U.S.C. 102(e) as being anticipated by US

7,757,240 by Miller et al.

4. Regarding **claim 1**, a file recording apparatus for editing video data in accordance with a command input by a user and recording the resultant edited video data in the form of a file,

- the file including
  - a block of real data management information which is organized in a hierarchical structure and which includes at least a source track in which management information associated with the video data is described and an effect track in which management information associated with an effect to be applied to the video data is described (fig. 9, col. 13 lines 63-col. 14 lines 57, fig. 19, col. 19 lines 19-52), and
  - a block of real data including at least real data associated with the effect track (fig. 9, col. 13 lines 63-col. 14 lines 57, fig. 19, col. 19 lines 19-52),
- the file recording apparatus forming, in the block of management information, at least

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- an alternate track including video data equivalent to video data obtained by performing a process according to the effect track (fig. 9, col. 13 lines 63-col. 14 lines 57, fig. 19, col. 19 lines 19-52), and
- information indicating the processing priority level assigned to the alternate track of the video data with respect to the processing priority level assigned to another track (fig. 9, col. 13 lines 63-col. 14 lines 57, fig. 19, col. 19 lines 19-52, col. 15 lines 3-11, col. 16 lines 4-32).

5. Regarding **claim 2**, the file recording apparatus wherein an alternate track for an alternative use of the effect track is formed in the block of management information, the alternate track including an effect which is an alternative to the effect described in the effect track (fig. 9, col. 13 lines 63-col. 14 lines 57, fig. 19, col. 19 lines 19-52).

6. Regarding **claim 3**, the file recording apparatus wherein the information indicating the priority level is described in a block of user data of the alternate track including the video data and also in a block of user data of the alternate track for alternative use of the effect track (fig. 9, col. 13 lines 63-col. 14 lines 57, fig. 19, col. 19 lines 19-52).

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7. Regarding **claim 4**, the file recording apparatus wherein in the block of the user data, property information associated with the corresponding track is described (fig. 9, col. 13 lines 63-col. 14 lines 57, fig. 19, col. 19 lines 19-52).

8. Regarding **claim 5**, the file recording apparatus wherein the alternate track including the video data is formed such that real data of the video that is assigned only in a period in which a change occurs in the video data when the effect track is applied to the video data (fig. 9, col. 13 lines 63-col. 14 lines 57, fig. 19, col. 19 lines 19-52).

9. Regarding **claim 6**, the file recording apparatus wherein the alternate track including the video data is a track of management information associated with an effect to be applied to another source track including video data obtained as a result of applying the effect track to the original video data (fig. 9, col. 13 lines 63-col. 14 lines 57, fig. 19, col. 19 lines 19-52).

10. **Claim 7** is rejected for the same reason as discussed in the corresponding claim 1 above.

11. **Claim 8** is rejected for the same reason as discussed in the corresponding claim 1 above.

12. **Claim 9** is rejected for the same reason as discussed in the corresponding claim 1 above.

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13. **Claim 10** is rejected for the same reason as discussed in the corresponding claim 1 above.

14. **Claim 11** is rejected for the same reason as discussed in the corresponding claim 1 above.

15. **Claim 12** is rejected for the same reason as discussed in the corresponding claim 1 above.

16. **Claim 13** is rejected for the same reason as discussed in the corresponding claim 1 above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) US 2002/0057705

b) US 2002/0010712

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIGAR CHOWDHURY whose telephone number is (571)272-8890. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NC  
08/14/2010

/JAMIE JO ATALA/  
Primary Examiner, Art Unit 2621